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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,697	01/24/2002	Tetsuya Matsui	381HI/50780	7835

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EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,697

Applicant(s)

MATSUI ET AL.

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 12/28/2004 is acknowledged and entered. Claims 1, 6-9 and 12 have been amended. Claims 1-18 are currently pending in the application.

Claim Rejections - 35 USC § 101

Claim Rejections under 35 USC § 101 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Frankland et al. (US 2002/0026339 A1).

Frankland et al. (hereinafter Frankland) teaches a system and method for managing changes in regulatory requirements for business activities at an industrial facility, comprising:

Claim 1. A server and a plurality of databases containing information on chemical and physical properties of materials used at a facility, including hazards associated with said materials, ecology-toxicity and environmental release information [0050]; [0416]; [0417]. Language reciting functionality of the server, including: "*setting: (a) the release amounts to each release-transfer destination of chemical substances*

that compose said materials..., (b) information for improving the environmental performance, according to information on these chemical substances that are released, (c) the information related to said release rates based on the release information ..., and (d) environmental performance information that evaluates environmental effects due to discharging chemical substances in the release amounts that correspond to the input amounts of said materials that are input...” is given no patentable weight. MPEP 2106 (II) (C) states: “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.”

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Furthermore, the examiner maintains that the server disclosed in Frankland *is capable* of performing said functions.

Claim 2. Said system, comprising: a database containing information on hazards associated with said materials, ecology-toxicity and environmental release information [0416]; [0417]. Information as to *said information is information that evaluates environmental effects ...* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 3. Said system, including a database containing information including investment effectiveness including tracking cost related to environmental health and safety regulations [0034]; [0385]; [0421].

Claims 4. Said system, comprising: a plurality of equipment; and said database contains information related to investment and environmental compliance effectiveness [0034]; [0421]. (Examiner understands the word *equipment* as encompassing plural items used in operation or activity. See: Merriam-Webster's Collegiate Dictionary; 10th ed.)

Claim 5. Said system, comprising: a database containing environmental release related information, which is represented in table format [0430].

Claim 6. Said system, comprising: a server and a plurality of databases containing information on chemical and physical properties of materials used at a facility, including hazards associated with said materials, ecology-toxicity and environmental release information [0050]; [0416]; [0417]. Language reciting functionality of the server, including: "*setting the release amounts to each release-transfer destination of chemical substances that compose said materials ..., wherein information related to an enterpriser that performs said certain process is output...*" is given no patentable weight. MPEP 2106 (II) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation."

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Furthermore, the examiner maintains that the server disclosed in Frankland *is capable* of performing said functions.

Claim 7. Said system, comprising: a server and a plurality of databases containing information on chemical and physical properties of materials used at a facility, including hazards associated with said materials, ecology-toxicity and environmental release information [0050]; [0416]; [0417]. Language reciting functionality of the server, including: “*setting the release amounts to each release-transfer destination of chemical substances that compose said materials..., wherein information related to an enterpriser that performs said certain process is output...*” is given no patentable weight. MPEP 2106 (II) (C) states: “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.”

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Furthermore, the examiner maintains that the server disclosed in Frankland *is capable* of performing said functions.

Claim 8. Said system, comprising: a server and a plurality of databases containing information on chemical and physical properties of materials used at a facility, including hazards associated with said materials, ecology-toxicity and environmental release information [0050]; [0416]; [0417]. Language reciting functionality of the server, including: “*setting the release amounts to each release-transfer destination of chemical substances that compose said materials..., wherein information*

related to an enterpriser that performs said certain process is output..." is given no patentable weight. MPEP 2106 (II) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation."

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Furthermore, the examiner maintains that the server disclosed in Frankland is *capable* of performing said functions.

Claim 9. Said system, comprising: a server and a plurality of databases containing information on chemical and physical properties of materials used at a facility, including hazards associated with said materials, ecology-toxicity and environmental release information [0050]; [0416]; [0417]. Language reciting functionality of the server, including: "*setting: (a) the release amounts to each release-transfer destination of chemical substances that compose said materials..., (b) information for improving the environmental performance, according to information on these chemical substances that are released, (c) the information related to said release rates based on the release information ..., and (d) environmental performance information that evaluates environmental effects due to discharging chemical substances in the release amounts that correspond to the input amounts of said materials that are input...*" is given no patentable weight. MPEP 2106 (II) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation."

Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 528-531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

Furthermore, the examiner maintains that the server disclosed in Frankland *is capable* of performing said functions.

Claim 10. Said system, including a database containing information including investment effectiveness including tracking cost related to environmental health and safety regulations [0034]; [0385]; [0421].

Claim 11. See reasoning applied to Claim 9 or 10.

Claim 12. Said method, including: Identifying the chemical substances of the materials used [0416]; identifying environmental hazards associated with materials used [0416]; tracking hazardous materials and wastes, including movement and environmental releases [0417]; [0419]; evaluating environmental effects due to discharging the hazardous materials and wastes during the releases [0417]; [0419].

Claim 15. Said system, comprising: a plurality of equipment; and said database contains information related to investment and environmental compliance effectiveness [0034]; [0421]. (Examiner understands the word *equipment* as encompassing plural items used in operation or activity. See: Merriam-Webster's Collegiate Dictionary; 10th ed.)

Claim 16. Said system, comprising: a plurality of equipment; and said database contains information related to investment and environmental compliance effectiveness

[0034]; [0421]. (Examiner understands the word *equipment* as encompassing plural items used in operation or activity. See: Merriam-Webster's Collegiate Dictionary; 10th ed.)

Claim 17. Said system, comprising: a database containing environmental release related information, which is represented in table format [0430].

Claim 18. Said system, comprising: a database containing environmental release related information, which is represented in table format [0430].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frankland in view of Fasca (US 2002/0065581 A1).

Claim 13. Frankland teaches all the limitations of claims 13-14, including implementing pollution prevention projects [0419]; except explicitly teaching evaluating the equipment that reduces chemical substances released.

Fasca teaches a system and method for reviewing historical data and performing forecasting simulations relating to pollutant emissions from power plant, wherein various pollution reducing equipment are considered [0044].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Frankland to include evaluating the equipment that reduce chemical substances released, as disclosed in Fasca, because it would allow managers of the industrial facility to find the best solution to meet the pollution

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generation threshold to comply with governmental regulations, as specifically stated in Fascal [0006].

Claim 14. Frankland teaches tracking hazardous materials and wastes, including distribution and use of the materials at the facility; and evaluating environmental effects due to discharging the hazardous materials and wastes during the releases [0419], thereby obviously indicating monitoring environmental effects in the case the equipment is installed.

Response to Arguments

Applicant's arguments filed 12/28/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Frankland does not teach a server which performs the various functions specified in the Claims, it is noted that Frankland specifically teach that the disclosed system is based on a multi-tier, server-based, Web-enabled computing model, and includes Web server and a database server [0050].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649 before April 13, 2005, and (571) 272-6801 after that date.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist before April 13, 2005, whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702 before April 13, 2005, and (571) 272-6812 after that date.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

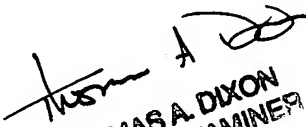
or faxed to:

(703) 872-9306

[Official communications; including After Final communications labeled "Box AF"]

IB

3/28/2005


THOMAS A. DIXON
PRIMARY EXAMINER